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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,189	02/04/2002	John Walter Liebeschuetz	00220/US	8453

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

10/030,189

Applicant(s)

LIEBESCHUETZ ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-16, 25, 29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-16, 25, 29 and 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.                      6) ☐ Other:

### DETAILED ACTION

1. Applicant's election with traverse of Group I piperidinyl compounds in Paper No. 4, dated April 22, 2003 is acknowledged. The traversal is on the ground that the examiner named the wrong compound in the reference cited for evidence of the Markush alternative being not novel however applicants have identified a the piperidine species which anticipating the claims and has proviso out this species. This is not found persuasive because the evidence showing that the Markush alternatives are not novel does not change since an anticipating species of piperidine, although provisos out, still provided such information.

The requirement is still deemed proper and is therefore made FINAL.

Claims 17, 18, 26, 27, 28, 30 have been canceled by preliminary amendment.

Claims 1-16, 29-25, 29, 31-35 being drawn to the piperidinyl compounds are examined.

2. Claims 4, 5, 34, 35 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants' regard as their invention.

It is noted that in the base claim 1, no definition for "L" was disclosed except as a part of the -L-Lp-(D)<sub>n</sub> system. No part of the system has been designated to be "L".

In the dependent claims 4, 5, 34, 35, the -Lp-(D)<sub>n</sub> was defined but no L was described. It is unclear what are the compounds of claims 4, 5, 34, 35 or whether they are the same invention as the base claim.

3. Claims rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 29-25, 29, 31-35 of U.S. Patent No. 2002/0151724 in view of US 6,262,069 (cited on 892 previously).

Determination of the scope and content of the prior art (MPEP §2141.01)

The instant claims are drawn to compounds wherein the cyclosubstituent on the piperidine ring is linked by a O or NH i.e. the "Q" moiety.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claims and the copending claims is that a two elements linker was inserted i.e. the Q moiety has two bonds. US 6,262,069 claimed a lipophilic moiety wherein the piperidine ring is linked to the substituents by one or two bonds (see col. 3-4 preferred structure at col. 4 and linker of one or two bonds at col. 3 lines 45-46).

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Finding of prima facie obviousness—rational and motivation (MPEP§2142-2143)


One skilled in the art in possession of claims of '724 and '069 is in possession of the instant claims **because** every elements of the instant claim is the same as the '724 claims except the linker which has been explicitly taught by the '069 claims. One skilled in the art is deemed to be aware of all the pertinent art in the field since one bond linker and two bond linker has been operable for the analogous compound of '069, one is clearly guided to modify the '724 claims with such linkage since such modification is enabled and expected to operate in similar manner in the similar compound of '069.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

OACS/Chang  
June 26, 2003

  
Celia Chang  
Primary Examiner  
Art Unit 1625